## REMARKS

I.    Introduction

This amendment is in response to the final Office Action dated August 19, 2009. A Request for Continued Examination accompanies this paper, and therefore Applicants respectfully request that that the amendments be entered.

The Office Action rejected claims 1, 4, 7-9 and 11-14 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,406,168 to Celi, Jr. et al. (Celi), in view of U.S. Application Publication No. 2002/0194331 to Lewis et al. (Lewis). Claims 2, 5, 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Celi in view of Lewis, and in further view of "RFC3261: SIP Session Initiation Protocol" to Rosenberg et al. (RFC3261). Claims 3 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Celi in view of Lewis, and in further in view of "RFC3515: The Session Initiation Protocol (SIP) Refer Method" to Sparks (RFC3515).

Claims 1, 6, 8, 11, 14 and 17 are amended, and claim 5 is canceled, herein. No new matter is added by the amendments, which are supported throughout the specification and figures. In particular, the amendments are supported at least at paragraph 0033 of the specification. Claims 1-4, 6-9 and 11-17 are pending.

II.    Rejections Under 35 U.S.C. 103(a)

In order to "establish prima facie obviousness of a claimed invention, **all claim limitations must be taught or suggested by the prior art**." (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); emphasis added).

Furthermore, "all words in a claim must be considered in judging the patentability of that claim against the prior art." (*In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). According to the Supreme Court, "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art," and it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." (*KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007)).

The present application provides the significant benefit of providing call setup in a VoIP network. An application server for providing the call feature processing is inserted in the call signaling path for purposes or setting up the call features, and removes itself when it is no longer required for the call feature processing.

Applicants have amended claim 1 to recite the features previously presented in the preamble in the body of the claim. Therefore applicants respectfully submit that the features of "an internet protocol network comprising the application server, [and] the application server for providing call feature processing" are properly recited in the body of the claim and therefore deserving of patentable weight.

Applicants maintain that the combination of Celi and Lewis is improper. Celi relates to integrating legacy telephone environments and IP networks, and specifically relates to providing load balancing and routing services on a ***packet-based telephone network***. In stark contrast, Lewis relates to incoming call notifications ***for a mobile station***. The SIP message in Lewis relates to a method of notifying a user of an incoming call, and does not relate to providing

call feature processing in a VoIP call. Applicants submit that the problems addressed by Celi are completely distinct from the problems and issues addressed in Lewis. The section of Lewis relied on in the Office Action discusses sending "the incoming call notification to an alternate destination instead of to **mobile station** 14". (Lewis; paragraph 0053; emphasis added). There is no suggestion or discussion relating to this service being provided by a call management system of a **voice over IP network**. Furthermore, the illustration of a packet-switched network 34 in figure 1 of Lewis does not disclose or suggest setting up internet protocol network calls, as recited in the preamble of claim 1. Applicants submit that the combination of the references is improper, and therefore the rejection based on the combination of the references should be withdrawn.

Amended claim 1 relates to a signaling method for use in setting up internet protocol network calls. The method of claim 1 includes:

> receiving at an application server call information whereby said application server is inserted into a signaling path for said call, **an internet protocol network comprising the application server, the application server for providing call feature processing**;

> providing call feature processing including determining a primary and alternate routing number for said call;

> determining, at said application server, whether said application server is

> required in the signaling path to complete call setup for said call; and

> if said application server is not required in the signaling path to complete said call setup, said application server removing itself from the signaling path;

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wherein said step of said application server
providing said call feature processing further
comprises the step of sending an SIP INVITE
message to a call control element in order to invoke
service of another network server, *said SIP INVITE
message containing a URL of a script identified
by the application server; and*

wherein said step of said application server
removing itself from the call signaling path further
comprises the steps of *sending to said call control
element a) an SIP redirect message or SIP
REFER message, and b) an SIP cancel to cancel
said INVITE message.*

Applicants have also amended claim 1 to include the features of claim 5,
and therefore the rejection of claim 1 is discussed in regard to the references
cited against canceled claim 5. The Office Action admits that Celi does not
disclose a method for an application server to remove itself from call processing
and including transmitting a SIP REDIRECT message to a call control element
(Office Action; page 9, middle). The Office Action cites figure 3 of Celi, which
apparently only shows a SIP proxy. The Office Action relies on RFC3261 as
alleged disclosure of the feature of the SIP REDIRECT. However, the cited
section of RFC3261 merely states that a server may take "themselves out of the
loop" (RFC3261; page 51, middle). There is no disclosure or suggestion in
RFC3261 of *sending to a call control element a) an SIP redirect message
or SIP REFER message, and b) an SIP cancel to cancel said INVITE
message*, as claimed in amended claim 1. In particular, there is no disclosure
in RFC3261 relating to a SIP cancel, nor more particularly that such a message
is sent to a call control element. Therefore, for at least this additional reason,
Applicants submit that claim 1 is allowable.

Additionally, Applicants have amended the claims to recite that "the invite
message contains a URL of a script identified by the application server". This

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feature provides the significant benefits discussed in the specification at least at paragraph 0033. For instance, the URL may identify a Voice Extensible Markup Language (VoiceXML) script that creates audio dialogs. Applicants respectfully submit that none of the prior art references disclose or suggest this feature. Therefore, for at least this additional reason, amended claim 1 is allowable.

Each of the other independent claims includes features similar to those discussed above in regard to claim 1, and therefore each of the other independent claims is allowable for at least the same reasons as claim 1 is allowable.

Each of the dependent claims depends from an allowable independent claim, and therefore each of the dependent claims is allowable for at least the same reasons as their respective base claim is allowable.

III.    Conclusion

Applicants respectfully request reconsideration of the present application and allowance of all pending claims.

If this communication is filed after the shortened statutory time period has elapsed and no separate Petition is enclosed (or the enclosed Petition is insufficient), the Commissioner of Patents and Trademarks is petitioned, under 37 C.F.R. § 1.136(a), to extend the time for filing a response to the outstanding Office Action by the number of months which will avoid abandonment under 37

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C.F.R. § 1.135. The fee under 37 C.F.R. § 1.17 should be charged to our
Deposit Account No. 06-2143.

Respectfully submitted,

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